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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,782	04/18/2007	Joseph Hermes Kaal	28091/210	2115
26774 7590 12/23/2010 NIXON PEABODY LLP - PATENT GROUP 1100 CLINTON SQUARE ROCHESTER, NY 14604				
EXAMINER				
SCOTT, BRANDY C				
ART UNIT		PAPER NUMBER		
3767				
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12/23/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/587,782

**Applicant(s)**

KAAL ET AL.

**Examiner**

BRANDY C. SCOTT

**Art Unit**

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-16 and 18-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-16 and 18-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

After further consideration, the finality of the previous office action is withdrawn, and prosecution is reopened. New grounds for rejection follow below.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-11, 13, 16, 18-22, and 24-29 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,494,863 to Shaw in view of U.S. Patent No. 5,084,017 to Maffetone.

#### In Reference to Claims 1-4, 7-11, 18-21, and 24-28

A disabling system for a syringe (Figures 15-19) comprising a plunger (handle 116) having a plurality of aligned steps (stepped serrations 124) disposed longitudinally along the plunger (Figure 15) and a collar (clip structure 114 and collar 126) mountable to the barrel (Figure 15), said collar comprising an inner member (collar 126) and an outer member (clip 114; Figure 16) having pawls (teeth 136) capable of engaging the ratchets of the plunger (Figure 18), said inner member operable to prevent engagement of the ratchets by the pawls (Figures 15, 17) until the plunger is depressed (col. 12, lines 8-20).

Shaw does not disclose the inner member comprising one or more projections to

prevent initial engagement of the ratchet by the at least one pawl until the plunger is depressed. Maffetone discloses a projection (guide pin, 85) to prevent initial engagement of the ratchet by the at least one pawl until the plunger is depressed (Figures 19-21). At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the device of Shaw with the projection (guide pin, 85) of Maffetone to prevent premature movement of the actuating rod into the solution dispensing mode (Column 7, lines 38-50).

Shaw in view of Maffetone do not disclose the projection (guide pin, 85) being resiliently deformable. It would have been an obvious matter of design choice to have the projection be resiliently deformable, since applicant has not disclosed that the deformability of the projection solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the stationary projection preventing premature movement of the actuating rod taught by Maffetone. In particular, Applicant states twice in the specification that the projection is "resiliently deformable" but never states that its deformability solves any stated problem.

In Reference to Claims 5, 13, 22, and 29

The device of claims 1, 18, and 28 (see above) wherein the inner and outer member are incapable of rotation relative to each other (col. 11, lines 39-42, wherein the outer member – clip 114- is in a fixed position relative to the barrel and therefore would be incapable of rotation relative to the inner member).

In Reference to Claim 16

A method of using a syringe comprising: providing a syringe comprising a plunger (handle 116) including at least one ratchet (serrations 124), a barrel (barrel 12) and a collar (clip 114 and collar 126), said collar comprising an inner member (collar 126) and outer member (clip 114) having at least one pawl (teeth 136); and depressing the plunger from a first position (Figure 15) at which the pawl is not engageable with the ratchet by at least one projection (catch 128) of the inner member positioned between the pawl and ratchet (Figure 15) to a second position (Figure 18) at which the pawl is engaged with the ratchet to prevent plunger withdrawal (Figure 18; col. 12, lines 27-34, wherein it is impossible to pull the handle 116 backwards when it is in the defined second position of Figure 18).

Shaw does not disclose the inner member comprising one or more projections to prevent initial engagement of the ratchet by the at least one pawl until the plunger is depressed. Maffetone discloses a projection (guide pin, 85) to prevent initial engagement of the ratchet by the at least one pawl until the plunger is depressed (Figures 19-21). At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the device of Shaw with the projection (guide pin, 85) of Maffetone to prevent premature movement of the actuating rod into the solution dispensing mode (Column 7, lines 38-50).

Shaw in view of Maffetone do not disclose the projection (guide pin, 85) being resiliently deformable. It would have been an obvious matter of design choice to have the projection be resiliently deformable, since applicant has not disclosed that the

deformability of the projection solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the stationary projection preventing premature movement of the actuating rod taught by Maffetone. In particular, Applicant states twice in the specification that the projection is "resiliently deformable" but never states that its deformability solves any stated problem.

3. Claims 6, 14, 15, 23, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,494,863 to Shaw (Shaw) in view of U.S. Patent No. 5,084,017 to Maffetone in view of UK Patent Application No. GB 2203047 to Banks (Banks).

In Reference to Claims 6, 14, 23, and 30

Shaw teaches the device of claims 5, 13, 22, and 29 (see above) but fails to teach two fingers on the outer member that are capable of engaging guide slots on the plunger. Banks teaches a syringe comprising a plunger 4 that has splines 7-10 that lock into guide channels 11-14 in order to prevent rotation of the plunger with respect to the syringe body (p. 5, lines 1-6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Shaw to have guide channels on the handle 116 and splines on the clip 114 as taught by Banks in order to prevent rotation of the plunger with respect to the syringe body (p. 5, lines 1-6).

In Reference to Claim 15

Shaw teaches a syringe comprising a barrel (barrel 12) that comprises two pawls (fingers 136; Figure 15); and a plunger (handle 116) comprising: two opposed ratchets (serrations 124) engageable by the two pawls (Figure 18) to prevent withdrawal of the plunger during or following depression of the plunger (col. 12, lines 27-34); wherein the barrel comprises a collar (clip 114 and collar 126) having an inner member (collar 126) operable to prevent engagement of the ratchet and pawls (Figure 15), the outer member (clip 114) comprising the two pawls (Figure 16). Shaw fails to teach two fingers on the outer member that are capable of engaging guide slots on the plunger. Banks teaches a syringe comprising a plunger 4 that has splines 7-10 that lock into guide channels 11-14 in order to prevent rotation of the plunger with respect to the syringe body (p. 5, lines 1-6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Shaw to have guide channels on the handle 116 and splines on the clip 114 as taught by Banks in order to prevent rotation of the plunger with respect to the syringe body (p. 5, lines 1-6).

Additionally, Shaw does not disclose the inner member comprising one or more projections to prevent initial engagement of the ratchet by the at least one pawl until the plunger is depressed. Maffetone discloses a projection (guide pin, 85) to prevent initial engagement of the ratchet by the at least one pawl until the plunger is depressed (Figures 19-21). At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the device of Shaw with the projection (guide pin, 85) of

Maffetone to prevent premature movement of the actuating rod into the solution dispensing mode (Column 7, lines 38-50).

Shaw in view of Maffetone do not disclose the projection (guide pin, 85) being resiliently deformable. It would have been an obvious matter of design choice to have the projection be resiliently deformable, since applicant has not disclosed that the deformability of the projection solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the stationary projection preventing premature movement of the actuating rod taught by Maffetone. In particular, Applicant states twice in the specification that the projection is "resiliently deformable" but never states that its deformability solves any stated problem.

### ***Response to Arguments***

3. Applicant's arguments, see pp. 8-11, filed 12/06/2010, with respect to the rejection(s) of claim(s) 1-11, 13-16 and 18-30 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a different interpretation of Maffetone. Applicant's argument that the projection of Maffetone is not "resiliently deformable" is considered persuasive. However, Applicant's specification does not disclose that the projection being resiliently deformable solves any stated problem or is for any particular purpose. Therefore, since Maffetone discloses a projection that performs the claimed function of preventing premature movement of the actuating rod, the material properties of the projection are considered an obvious matter of design choice.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDY C. SCOTT whose telephone number is (571)270-7410. The examiner can normally be reached on Monday-Friday, 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. C. S./  
Examiner, Art Unit 3767

/Patricia Bianco/  
Supervisory Patent Examiner, Art Unit 3772  
For Kevin Sirmons